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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/727,177	12/03/2003	Mary C. Tannenbaum	005708/P010US/08008819	5985

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DALLAS OFFICE OF FULBRIGHT & JAWORSKI L.L.P.  
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EXAMINER

GAUTHIER, GERALD

ART UNIT

PAPER NUMBER

2614

DATE MAILED: 04/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/727,177	<b>Applicant(s)</b> TANNENBAUM, MARY C.	
	<b>Examiner</b> Gerald Gauthier	<b>Art Unit</b> 2645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 21 March 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-36,44 and 48-51 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-36,44 and 48-51 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. **Claim(s) 1-36, 44, and 48-51** are rejected under 35 U.S.C. 103(a) as being unpatentable over Hogan et al. (US 5,646,982) in view of Silver et al. (US 2004/0131162 A1).

Regarding **claim(s) 1**, Hogan discloses a system for recording messages (FIG. 9 and column 1, lines 17-19), said system comprising:

a memory for receiving at least some of said messages containing within said message controlled play time (column 12, lines 19-26); and

a device for playing each received message at the controlled play time associated with said received message (column 12, lines 27-32).

Hogan discloses the delivery time of a message but fails to disclose the play time contained within the message.

However, Silver teaches the play time as part of the message (paragraph 0046).

Therefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Hogan using the teaching of reminder message as taught by Silver.

This modification of the invention enables the system to have the play time contained within the message so that the user would receive the message on the specified time.

Regarding **claim(s) 2 and 34**, Hogan discloses a system, wherein said messages are received by a message recipient and wherein said message is played at said controlled play time without regard to any action taken by said message recipient (column 13, lines 26-30).

Regarding **claim(s) 3**, Hogan discloses a system, wherein said messages are audio messages played by a speaker (column 13, lines 6-16).

Regarding **claim(s) 4**, Hogan discloses a system, wherein said messages are video messages displayed on a display (column 12, lines 27-32).

Regarding **claim(s) 5**, Hogan discloses a system, wherein said messages are a combination of video and audio messages (column 12, lines 27-32).

Regarding **claim(s) 6 and 35**, Hogan discloses a system, wherein at least one of said messages contains a call-back number, said system further comprising;

a transmitter (column 12, lines 27-32);

an input for receiving a response to a played message (column 12, lines 27-32);

and

means for enabling said transmitter to send said response to said call-back number (column 12, lines 27-32).

Regarding **claim(s) 7 and 20**, Hogan discloses a system, wherein said controlled play time is a plurality of different times (column 12, lines 27-32).

Regarding **claim(s) 8, 21, 33 and 48**, Hogan discloses a system, wherein said memory receives messages that do not have controlled play times contained within said messages and wherein said system further comprises: a processor operable in response to instructions received with said message having controlled play times contained within said messages for controlling the play of a selected one of said messages not having controlled play times associated therewith (column 12, lines 27-32).

Regarding **claim(s) 9, 24, 49 and 50**, Hogan discloses a system, wherein said selected message is selected based on information available at the time a received message is played (column 13, lines 26-30).

Regarding **claim(s) 10 and 22**, Hogan discloses a system, wherein the selection of said selected message is controlled, at least in part by information received from a message sender (column 13, lines 26-30).

Regarding **claim(s) 11, 23 and 31**, Hogan discloses a system, wherein the selection of said selected messages is controlled, at least in part, by local sensors (column 13, lines 26-30).

Regarding **claim(s) 12 and 30**, Hogan discloses a system, wherein said sensors are selected from the list of thermometer, clock, GPS, calendar, physiological (column 13, lines 26-30).

Regarding **claim(s) 13 and 25**, Hogan discloses a system, wherein a played one of said messages is played continuously for a period of time as controlled by information received with the message (column 13, lines 26-30).

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Regarding **claim(s) 14 and 29**, Hogan discloses a system, wherein said messages are received by a plurality of memories in a broadcast mode, said memories associated with different receiving users (column 12, lines 19-37).

Regarding **claim(s) 15 and 26**, Hogan discloses a system, further comprising an override control for playing selected ones of said messages at a time established independent of said controlled time associated with said selected ones of said messages (column 13, lines 26-30).

Regarding **claim(s) 16 and 51**, Hogan discloses a system, wherein said device, at a controlled playtime, enables downloading of pre-identified messages stored at a location remote from said system (column 13, lines 26-30).

Regarding **claim(s) 17 and 32**, Hogan discloses a system, further comprising: means for converting any played message to a particular format, said particular format controlled by said messaging system (column 13, lines 26-30).

Regarding **claim(s) 18, 27 and 36**, Hogan discloses a system, wherein said controlled play time is a message recipient specific time category, instead of a specific time (column 13, lines 26-30).

Regarding **claim(s) 19**, Hogan in combination with Silver discloses all the limitation of **claim(s) 19** as stated in **claim(s) 1**'s rejection above and furthermore Hogan discloses establishing a communication connection with a memory device associated with said receiving party (column 13, lines 7-17); and

providing over an established communication connection a message playing time for a message to be played to said receiving party at said message playing time (column 13, lines 18-25).

Regarding **claim(s) 28**, Hogan in combination with Silver discloses all the limitations of **claim(s) 28** as stated in **claim(s) 1**'s rejection above and furthermore Hogan discloses a processor for controlling receipt of incoming messages (908 on FIG. 9).

Regarding **claim(s) 44**, Hogan in combination with Silver discloses all the limitations of **claim(s) 44** as stated in **claim(s) 1**'s rejection above and furthermore Hogan discloses playing each said stored message for said recipient at said time associated with said stored message without action taken by said recipient at the time each said message is played (column 13, lines 26-30).



***Response to Arguments***

4. Applicant's arguments with respect to **claim(s) 1-36, 44 and 48-51** have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerald Gauthier whose telephone number is (571) 272-7539. The examiner can normally be reached on 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
**GERALD GAUTHIER**  
**PATENT EXAMINER**

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April 5, 2006

Gerald Gauthier  
Examiner  
Art Unit 2645